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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,727

04/21/2006

Julia Ruth Dean

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OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

EXAMINER

GRABOWSKI, KYLE ROBERT

ART UNIT

PAPER NUMBER

3725

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,727	Applicant(s) DEAN, JULIA RUTH	
	Examiner Kyle Grabowski	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/21/06, 12/12/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 33-37 were withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/12/08. The examiner agrees with the applicant that no serious burden would be necessary for prosecution of claims 33-37; this is in light of the cited prior art also anticipating claims 33-37. As such, claims 1-43 are prosecuted on their merits.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Regarding claims 6, 9, 13, and 14, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render

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a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, as an example, claim 6 recites the broad recitation "wherein each dot has a maximum lateral dimension of less than 1.5mm", and the claim also recites "preferably less than 1mm" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 7-8, 10-12, 15-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Howland et al. (US 6,089,614).

6. In respect to claim 1, 3-5, 31-34, 38-43, Howland et al. disclose a security device provided on a substrate 1 and comprising one or more printed or transferred first areas 7, each first area 7 having one or more first colours; one or more printed or transferred second areas 7 on the same side of the substrate as the first area(s), each second area having one or more second colours (both portions of first indicia 7, Col. 3, 33-39),

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wherein at least one of the first and second areas comprises a discontinuous pattern (inferred from an offset or screen printing operation that results in halftones - containing an array of similarly sized circles) Col. 4, 33-36), and wherein the first area or areas surrounds the second area or areas, each first area being distinguishable from the second area or areas and wherein the first area(s) and/or second area(s) define an image (the creation of a geometric image e.g. circle, star, square, results in a surrounding area and an interior area, Col. 3, 33-39); and, a camouflage pattern 10 provided over the image 7 and at least an adjacent region surrounding the image ("further indicia) on the same side of the substrate as the first and second areas (Col. 3, 40-50), the camouflage pattern "image" having a colour and pattern such that in combination with the first and second areas, it renders the image substantially invisible when viewed under reflected light but visible when viewed in transmission (Abstract); the security device is provided on a substrate 1 which may comprise a paper material (Col. 4, 37-40)

7. In respect to claim 2, the first indicia 7 may comprise stochastic dots (Fig. 9A).

8. In respect to claims 7, 8, 12, 23, and 27, the first indicia 7 (which contains both first and second areas as explained above) may be a single color (Col. 5, 30-31) or multiple/rainbow colors (Col. 8, 18-19).

9. In respect to claims 10 and 17, again, a halftone array resulting from the printing technologies will result in a "line pattern" since the halftone area is a regular (non-random) array.

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10. In respect to claim 11, the “background pattern” uncovered by halftones in printing in indicia 7 and elements making up the camouflage pattern 10 span approximately the same region (Fig. 2).

11. In respect to claims 15, 18, and 30, the camouflage may comprise a pearlescent “white” material (Col. 8, 8-11) which is similar to the background areas between the printed discontinuous areas (the color of the paper substrate).

12. In respect to claim 16, the first indicia may comprise a rainbow of colors as described above, therefore contrasting with the pearlescent camouflage.

13. In respect to claims 19 and 25, the first indicia 7 (with first and second areas) may be printed with gravure or screen printing; (Col. 4, 33-36); Although the type of printing to provide the camouflage layer is not disclosed, although a product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

14. In respect to claims 20 and 35-37, the first indicia 7 (containing the discontinuous pattern) may comprise metal inks or optically variable inks (Col. 8, 12-19); Howland et al. do not disclose a demetallisation process however, although a product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of

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production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

15. In respect to claims 21, 22, and 26, Howland et al. do not disclose how the discontinuous pattern being transfers from a carrier or printed simultaneously, however, although a product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

16. In respect to claim 24, as described above, further indicia on the same side of the substrate as the first and second areas may form a larger design, as evident by “registration” between the further indicia and first and second areas (Col. 3, 47-57).

17. In respect to claim 28 and 29, as best construed by the examiner, the further indicia in association with the image can consist of, geometric shapes, line patterns, etc. the screen printing or offset printing resulting in solid colored dots.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. Claims 6, 9, 13-14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Howland et al. (US 6,089,614) in view of *Understanding Halftones*. As discussed above, Howland discloses printing processes such as offset or screen printing which provide dots or halftones of ink but does not disclose particular sizes or ink coverage of the halftones (used for either the discontinuous pattern of the first indicia or the camouflage pattern) however *Understanding Halftones* discloses the relationships between ink coverage, dot size, spacing, etc. and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide dot or element sizes for the discontinuous pattern and camouflage pattern taught in Howland et al. with

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suitable sizes and/or ink coverage in view of *Understanding Halftones* to provide sufficient functionality to the invention as described (Abstract, Howland et al.). The claim would have been obvious because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary common sense. Modifying ink density by spacing and size of halftones is well known in the printing art and it is within the technical grasp of one of ordinary skill in the art to modify these dimensions to provide an expected result (e.g. providing less ink coverage to allow for more light transmission). Furthermore, there is no criticality present in the specification for the specific ranges claimed (e.g. to “generally provide 50-80% ink coverage” or to provide a discontinuous pattern that will be “typically less than 1.5mm” Pg 4) .

Conclusion

21. Overall, it is believed that Howland et al. discloses all the elements of the present application or alternatively, techniques well known in the art would be obvious to modify Howland et al. It may be noted by the applicant that the second set of indicia 9 (Fig. 2, Howland et al.) is ignored and likewise is irrelevant to the indicia 7 which is believed to be identical to a first and second area, one forming a discontinuous pattern, which is disclosed in Howland as a geometric shape provided via an offset or screen printing process (using halftone dots).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571)272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Grabowski/
Examiner, Art Unit 3725

/Dana Ross/
Supervisory Patent Examiner, Art
Unit 3725